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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,776	10/09/2006	Francesco Viaro	22106-00124-US1	4412
30678 7590 12/23/2008 CONNOLLY BOVE LODGE & HUTZ LLP 1875 EYE STREET, N.W. SUITE 1100 WASHINGTON, DC 20006				
EXAMINER WONG, ALBERT KANG				
ART UNIT		PAPER NUMBER		
2612				
MAIL DATE		DELIVERY MODE		
12/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/599,776

**Applicant(s)**

VIARO ET AL.

**Examiner**

ALBERT K. WONG

**Art Unit**

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 09 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

1. This Office action is in response to the application filed October 9, 2006. This application is a 371 of PCT/EP05/03637, filed April 5, 2005 which claims the benefit of application MI2004A000761, filed April 19, 2004. Claims 1-13 are pending.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1- are rejected under 35 U.S.C. 103(a) as being unpatentable over Montjean (2002/0075616).

Regarding claim 1, the claimed wireless communication system for transmitting locally to a dedicated computerized device is shown as the means to communicate between monitor (item 3) and cell phone (item 17). Montjean does not explicitly teach what information is communicated. However, input reference values are received from the phone for input into the monitor. The reference values are set to determine the operation of the protection system. Further, the reference teaches that the communication is bi-directional. One of ordinary skill in the art would recognize that since the purpose of the phone is to update operational parameters in

the system, it would have been obvious to send data pertaining to the measured values or status of the monitor to the phone for evaluation by the user. Therefore, it would have been obvious to at least send measured quantities or current setting parameters to the phone so that the user can evaluate the function of the monitor before changing any operating parameters.

Regarding claim 2, the figure shows a cell phone.

Regarding claim 3, since the transmitter circuitry in the monitor is within the same box as the monitor, it is considered an integral part of the communication device.

Regarding claim 4, it is conventional to make communications means a modular component of systems to allow easy update of the communication protocols. Further, the courts have held that making something that is integral a separate unit would have been obvious.

Regarding claims 5-6, as shown by these claims the accessory module is either inside or outside of the circuit breaker. Since either location is functional, it is not critical to the invention and thus, would be considered an obvious design choice. Montjean does not disclose either configuration. Instead, the accessory module is co-located with the circuit breakers.

Regarding claim 7, Montjean discloses a Bluetooth connection. One of ordinary skill in the art would recognize that Bluetooth automatically establishes a connection when a recognized or allowed device is within communication range.

Regarding claim 8, the claimed push-button set may be considered an on switch for the transmitter. It would have been obvious to include an on/off switch to reduce the power consumption when communication is not required.

Regarding claim 9, one of ordinary skill in the art would recognize that a cell phone may communicate with a plurality of different transmitters. Similarly, it would have been obvious to

have one phone be able to communicate with a plurality of protection devices so that the user does not have to carry a separate phone to communicate with each device.

Regarding claim 10, it is conventional in monitoring systems to dedicate a particular time slot to communicate with each device so that the transmissions of each device would not interfere with each other. That is the principle of time division multiplexing. It would have been obvious to use known communication protocols.

Regarding claim 11, within any communication system there exist protocols to ensure proper communications. Where multiple communications compete for access, there must exist a hierarchical protocol so that each device awaits its turn. For example, every person speaks at the same time, no one is able to be heard. It would have been obvious to place critical data on a higher hierarchical protocol than less important data.

Regarding claim 12, the monitor in Montjean includes a display that shows measurements and parameters. These values are transmitted and the display is set within the local neighborhood of the protection device.

Regarding claim 13, Montjean teaches that the monitor is a circuit breaker. The type of circuit breaker is considered a design choice since the communication/monitoring system would be applicable to any type of circuit breaker.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The particular cited areas of the applied reference should not be considered to be the sole teaching of the claimed subject matter. Further, all of the cited references should be considered since they are considered to be relevant to the invention and teach or make obvious various aspects claimed.

6. Also, the Examiner has given Official notice that certain elements and/or principles are conventional. If applicant wishes to traverse these notices he must make a declaration that such principles are incorrect or not known with corresponding reasoning. Blanket, conclusory statements will be considered non-responsive. Further, assertions that items or principles are not known should be based upon a bona fide belief of the applicant. Intentional misleading statements may be considered inequitable conduct.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALBERT K. WONG whose telephone number is (571)272-3057. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian A. Zimmerman can be reached on 571-272-3059. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Albert K Wong/  
Primary Examiner, Art Unit 2612

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December 18, 2008